



06-14-2001

U.S. Patent & TMO/TM Mail Rcpt Dt #70

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT
AND
TRADEMARK OFFICE

In re application of:

Tickets.com, Inc.

Serial No.: 75/870,898

Filed: December 13, 1999

For: TICKETS@HOME

)
) Examining Attorney:

) Gerald T. Glynn

)
) Trademark Law Office 106

REQUEST FOR RECONSIDERATION

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
Box: RESPONSES
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

This Request for Reconsideration concerns the Final Office Action mailed on December 15, 2000. Applicant has filed concurrently herewith a Notice of Appeal, appealing the referenced Final Office Action. A copy of the Notice of Appeal is submitted herewith for the Examining Attorney's convenience.

I. DESCRIPTIVENESS REFUSAL – FINAL

The Examining Attorney has refused registration on the Principal Register on the ground that the proposed mark is descriptive of the covered services. The Examining Attorney has indicated, however, that Applicant may amend the subject Application to seek registration on the Supplemental Register. Applicant requests reconsideration of the Examining Attorney's decision because the suffix portion of its mark, @HOME, is not descriptive, but is instead suggestive, of the covered services.

WORD-SF\FMC\61259762.1

A. The Term @HOME Does Not Describe Applicant's Services

A mark is deemed merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986). The Examining Attorney has indicated that he considers Applicant's mark descriptive because the term TICKETS@HOME immediately informs and merely describes the salient feature of ticketing services which afford the user the capability of printing tickets online at home. Applicant will demonstrate, however, that, as applied to its services, the word @HOME is suggestive, rather than descriptive. As such, Applicant's mark is entitled to reconsideration and, ultimately, registration on the Principal Register.

Applicant is seeking to register the mark TICKETS@HOME for use in connection with the following services: "online ticketing services, namely arranging for tickets for shows and other entertainment events via global computer network." Applicant is not seeking to register said mark for services which enable users to print physical tickets to events or shows on their computer printers. Because Applicant disclaimed the word TICKETS apart from the mark as a whole in its response to the prior Office Action, only the term @HOME is at issue here. That term does not describe the foregoing services or any aspect of those services.

As the Examining Attorney has noted, it is the ultimate consumer reaction which determines whether a mark is merely descriptive. In this technology-driven time, consumers have learned not to interpret the term @HOME literally. Rather, to consumers, the term @HOME connotes goods or services that implicate computers or the global area network. The growing number of @HOME marks on the Principal Register, or approved by the Patent and Trademark Office for registration on the Principal Register, is indicative of this trend. *See e.g.*

Reg. No. 2,211,491 (@HOME for "providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information"); Reg. No. 2,001,224 (@HOME for "entertainment in the nature of an on-going television program in the field of computer news, education and information."); App. Serial No. 74/654,927 (@HOME for "cable television transmission services" – Notice of Allowance issued for Principal Register); App. Serial No. 75/770,937 (PRINT@HOME for "electronic transmission of printed information to consumers via computer terminals" – Notice of Allowance issued for Principal Register); App. Serial No. 75/774,346 (MEALS@HOME for "ordering services for the purchase of consumer products and services via telephone, facsimile, or online over a global area network" – Notice of Allowance issued for Principal Register); and App. Serial No. 76/176,362 (CONNECTED@HOME for "computers and computer hardware" – approved for publication for Principal Register). Accordingly, consumers might reasonably understand the term @HOME to indicate services that are available over or involve the Internet. They would not, by contrast, assume that such services are available only or primarily from one's home.

Moreover, the term @HOME does not describe Applicant's services as it is simply incidental that said services may be accessed from one's home. Indeed, Applicant's services are available to consumers at any location from which the Internet may be accessed. Given today's technology, consumers are now able to and do access the Internet, and therefore Applicant's services, from virtually anywhere. Consumers routinely log onto Applicant's web site from the office, school, library, airplane, train, boat and car using desktop computers, laptop computers, cellular telephones, personal digital assistants, and an ever-expanding myriad of other devices.

Neither does the mark describe the manner in which tickets are distributed. Currently, consumers arranging for tickets on Applicant's web site cannot print or otherwise instantly access

those tickets from their computer terminals. Rather, the physical tickets must either be picked up by the purchaser at a "Will Call" booth for the relevant event or show or be shipped to the purchaser via a selected shipping method. Thus, tickets are not literally available at one's home, rendering the term @HOME non-descriptive of the relevant services.

Because the average consumer would not readily connect the term @HOME with online services featuring the sale of tickets, the suffix portion of Applicant's mark does not merely describe the indicated services. As such, Applicant's mark is entitled to registration on the Principal Register.

B. Applicant's Mark Clearly is Suggestive of the Identified Services

"A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods [and services]. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and services]." J. Thomas McCarthy, *Trademarks and Unfair Competition*, 4th Ed., §11:67, pgs. 110-11 (1996) (citing *Stix Prod. Inc. v. United Merchants and Manufacturers, Inc.*, 295 F.Supp. 479, 160 U.S.P.Q. 777 (SDNY 1968)). Under this test, the suffix portion of Applicant's mark – @HOME – is clearly suggestive of the indicated services.

There is no question that the term @HOME does not readily convey to the relevant consuming public the online ticketing services described above. Rather, thought and imagination is required to determine that Applicant provides online services through which consumers arrange for tickets to shows and other entertainment events and then obtain physical tickets by visiting the "Will Call" booth at the relevant show or event or by having the physical tickets delivered to them. The mark simply suggests that Applicant offers some form of goods or

services that implicate computers or computer networks. Accordingly, the suffix portion of Applicant's mark is, at the very least, suggestive of the relevant services.

Finally, it is well settled that any doubt as to descriptiveness should be resolved in favor of the Applicant. *In re Noble Co.*, 225 U.S.P.Q. 749-50 (TTAB 1985). If the Examining Attorney has any reservation as to whether Applicant's mark is merely descriptive of the relevant services, the mark should be passed to publication and ultimately registered. Applicant respectfully requests that the Examining Attorney withdraw his final refusal of registration of the subject trademark on the basis of mere descriptiveness.

II. REMARKS

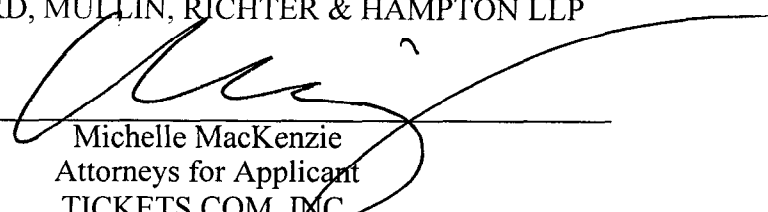
Applicant has demonstrated that the suffix portion of its mark -- @HOME -- is not descriptive of the services offered by Applicant but, instead, is suggestive of those services.

If the Examining Attorney requires any additional documentation or information in support of this showing, or has any other questions, he is urged to contact the undersigned attorney. Applicant respectfully requests that the Examining Attorney withdraw his objection to the mark as descriptive and pass the subject mark to publication in the Official Gazette for registration on the Principal Register at the Examining Attorney's earliest convenience.

Dated: June 14, 2001

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of:)

Tickets.com, Inc.)

Serial No.: 75/870,898)

Filed: December 13, 1999)

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NOTICE OF APPEAL

Hon. Asst. Comm. For Trademarks
United States Patent and Trademark Office
Box: TTAB - FEE
2900 Crystal Drive
Arlington, VA 22202-3513

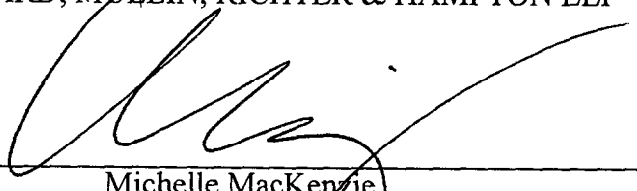
Sir:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney refusing registration on the Principal Register of the referenced Application.

Dated: June 14, 2001

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By _____


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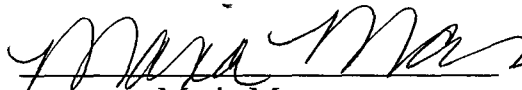
CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" Mailing Label Number: _____

EK234600260US

Date of Deposit: June 14, 2001.

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Asst. Commissioner of Patents and Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



Maria Mares